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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,839	03/24/2000	Ernst Michael Winter	45/276 LI/SCH	2969
30996	7590	04/25/2005	EXAMINER	
ROBERT W. BECKER & ASSOCIATES 707 HIGHWAY 66 EAST SUITE B TIJERAS, NM 87059			LAVINDER, JACK W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/446,839

Applicant(s)

WINTER ET AL.

Examiner

Jack W. Lavinder

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the phrase "said gemstone being suitable only for technical or industrial purposes" is considered indefinite. What is the scope of this limitation? First, what are technical or industrial purposes? Secondly, the scope of the limitation is indefinite. Some gemstones considered only for industrial purposes have been used to ornate jewelry, i.e., crushed diamonds have been embedded in rings, bracelets or necklaces. Only types of stones, cut or uncut, polished or unpolished can be used for something other than technical or industrial purposes. Crushed or broken diamonds or any other precious or semiprecious stones can be used in making artwork or jewelry. Also, uncut and unpolished stones can be used in rock gardens or in mosaics or in jewelry.

The term "gemstone" according to Webster's New Riverside University Dictionary is defined as "A precious or semiprecious stone that may be used as a jewel when cut and polished." The phrase "only for technical or industrial purposes" in the limitation contradicts with the definition that the gemstone "may be" used as a jewel when cut and polished. In other words, the term gemstone encompasses cut and polished stones and

Art Unit: 3677

uncut and unpolished stones. Is the applicant intending by the phrase “only for technical or industrial purposes” to narrow the gemstone to be only precious and semiprecious stones that are uncut and unpolished? If they are, the limitation is still unclear, since uncut and unpolished stones can be and have been used in jewelry.

***Claim Objections***

3. Claim 22 is objected to because of the following informalities: a term is missing between “visible surface” and “one or more” in line 2 of the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14-18, 20, 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Normann, Jr., 4809417.

Regarding claim 14, Normann, Jr. discloses a gemstone body (14) with a visible surface (28), i.e., visible through the top part (12, col. 3, lines 5-10), that supports a precious metal (gold, col. 3, lines 65-end and column 4, lines 1-11) structured material layer.

Regarding claim 15, Normann, Jr. discloses that the visible surface is smooth (28).

Regarding claims 16 and 17, Normann, Jr. discloses that the material layer is gold, which is considered to be shiny and a precious metal.

Regarding claim 18, Normann, Jr. discloses an intermediary retention layer (48, zirconium, col. 6, lines 21-38) in between the visible surface (28) and the gold material layer (50).

Regarding claim 20, Normann, Jr. discloses a body that can be made of a multitude of materials (col. 3, lines 35-56), which includes a diamond. The process by which the diamond is formed is given weight inasmuch as to the final structure achieved by the process, i.e., a diamond support layer. Normann, Jr. discloses a diamond support layer (14, 40).

Regarding claim 22, Normann, Jr. discloses a level visible surface (28).

Regarding claim 23, Normann, Jr. discloses a transparent protective layer (12 or 70).

Regarding claim 24, Normann, Jr. discloses a protective layer made from diamond (col. 3, lines 6-11).

Regarding claim 25, Normann, Jr. discloses a body adapted to form a face of a clock, i.e., the flat level surface (28) of the body is ideal for forming a clock face, albeit a small clock face.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3677

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Normann, Jr.

Regarding claim 19, Normann, Jr. discloses an intermediary layer made from zirconium. The claim requires that the layer be made from titanium or chromium. These materials are well known to the artisan for changing the color or look of jewelry. It would have been an obvious design choice to use either of the known materials, titanium or chromium, in place of Normann, Jr.'s zirconium material in order to produce a different colored jewelry item to be more pleasing to the wearer.

Regarding claim 21, Normann, Jr. discloses that a multitude of different materials can be used (col. 3, lines 35-56) to form the support body of the jewel. Polycrystalline diamond aggregate is an old and well known material. It would have been an obvious design choice to make Normann, Jr.'s diamond support from polycrystalline diamond aggregate, in order to vary the final appearance of the jewel to make it more attractive to the wearer.

### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

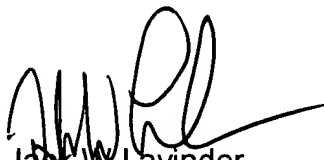
Art Unit: 3677

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jack W. Lavinder  
Primary Examiner  
Art Unit 3677

4/20/05